REMARKS

This application has been reviewed in light of the Office Action dated March 1, 2004. Claims 39-46 are presented for examination, of which Claims 39, 43, and 44 are in independent form. Claims 45 and 46 have been added to provide Applicants with a more complete scope of protection. Claims 39-44 have been amended to define still more clearly what Applicants regard as their invention. Favorable reconsideration is requested.

An Information Disclosure Statement and a corresponding PTO-1449 form were submitted on October 29, 2003, as evidenced by the returned receipt postcard bearing the stamp of the U.S. Patent and Trademark Office, a copy of which is attached hereto. Applicants respectfully request the Examiner to return an initialed copy of that PTO-1449 form, indicating that the references listed thereon have been considered and made or record in the present application.[1]

Claims 39, 41, 43 and 44 were rejected under 35 U.S.C. § 112, first paragraph, as not being supported by original disclosure sufficient to convey that Applicants had possession of the subject matter of those claims as of their fling date. The claim recitations which formed the basis for this rejection (as to Claims 39, 43 and 44) have been rewritten to clarify them, since it is believed that this rejeciton was based on a misapprehension of what Applicants were claiming. Also, the language of Claim 41 has been amended to adhere more closely to the

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[1] Applicants also note that they filed an additional Information Disclosure Statement on April 20, 2004 (subsequent to the mailing of the outstanding Office Action), and assume that the Examiner will return a copy of the form PTO-1449 filed therewith, with her next paper.

language of the specification at page 45 (as quoted in the Office Action). Accordingly, withdrawal of this rejection is respectfully requested.

Claims 39 and 41-44 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,098,065 (Skillen et al.), and Claim 40 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Skillen in view of U.S. Patent 5,297,042 (Morita).

Independent Claim 39 is directed to an information providing method for providing information to a user, comprising a first storing step, of storing in a first database a code, first information corresponding to the code and a keyword associated with the first information. In a first search step, a search is performed in the first database for first information corresponding to an inputted code, and in an obtaining step, there is obtained a first keyword associated with the first information searched for in the first search step. A second search ste is performed, in which a search is made for second information based on the first keyword obtained in the obtaining step, and in an output step, the first information searched for in the first search step is outputted together with the second information searched for in the second search step.

Among other important features of Claim 39 are searching in a first database for first information corresponding to an inputted code, searching for second information (e.g., an advertisement) based on a keyword (information profile data), which is stored in advance in the first database and which is associated with the first information, and outputting the first information together with the second information. Thus, the method of Claim 39 searches for

the second information based directly on the keyword, which in turn is based on the first information.

Skillen relates to an advertisement machine that provides advertisements to a user who is searching for information on a network. A search argument is included in a search request input by the user, and the machine searches a first database based on that search argument, and also correlates the same search argument to an advertisement in a second database. Both search results (that from the first database and the advertisement from the second database) are provided to the user. Thus, in the *Skillen* approach, both searches are performed based on the same search argument. Nothing has been found or pointed out in *Skillen* that would teach or suggest performing a second search based on a keyword derived from the first search argument, as recited in Claim 39. Even if *Skillen* provides for the advertisement search to be performed either based directly on the first search argument or by creating a logical tree analysis of possible product fits and select a best fit (see col. 4, lines 31-40), nothing in that description (or elsewhere in *Skillen*) is seen to suggest searching for first information based on an inputted code, and obtaining a keyword associated with the first information found in that search, and searching based both on the keyword, as recited in Claim 39. For at least that reason, it is believed to be clear that Claim 39 is allowable over that patent.

Independent Claims 43 and 44 are an apparatus and a program-product claim, respectively, corresponding to method Claim 39, and are believed to be patentable for at least the same reasons as discussed above in connection with Claim 39.

A review of the other art of record, including *Morita*, has failed to reveal anything which, in Applicants' opinion, would remedy the deficiencies of the art discussed above, as a reference against the independent claims herein. Those claims are therefore believed patentable over the art of record.

The other claims in this application depend from one or another of the independent claims discussed above and, therefore, are submitted to be patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, individual consideration or reconsideration, as the case may be, of the patentability of each claim on its own merits is respectfully requested.

This Amendment After Final Action is believed clearly to place this application in condition for allowance and, therefore, its entry is believed proper under 37 C.F.R. § 1.116. Accordingly, entry of this Amendment, as an earnest effort to advance prosecution and reduce the number of issues, is respectfully requested. Should the Examiner believe that issues remain outstanding, it is respectfully requested that the Examiner contact Applicants' undersigned attorney in an effort to resolve such issues and advance the case to issue.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

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